

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q77492

Takashi OHIRA

Appln. No.: 10/662,330

Group Art Unit: 1762

Confirmation No.: 9180

Examiner: Elena TSOY

Filed: September 16, 2003

For: GOLF BALL PREPARATION METHOD AND GOLF BALL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the final Office Action mailed January 16, 2007, and the Advisory Action mailed April 20, 2007, Applicant files this Pre-Appeal Brief Request for Review. The present Request is also accompanied by the filing of a Notice of Appeal.

I. RESPONSE TO REJECTION UNDER 35 U.S.C. § 103

Referring to Section No. 6 at pages 2 and 3 and Section No. 9 at page 5 of the final Office Action, Claims 1 and 3-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,165,564 (“Crastr”) in view of U.S. Patent Application Publication No. 2002/0016226 (“Jin”), further in view of U.S. Patent No. 6,319,983 (“Lokai”), and further in view of U.S. Patent No. 5,300,325 (“Nealon”).

For each one of the independent reasons presented in the Response filed April 13, 2007, and the Amendment filed December 5, 2006, the applied combination of art does not disclose or suggest the presently claimed subject matter. Accordingly, the remarks presented at Section I on

pages 2-4 of the April 2007 Response and at Section II on pages 3-7 of the December 2006 Amendment are hereby incorporated by reference.

In the Advisory Action mailed April 20, 2007, the examiner states that “Applicant’s arguments filed April 13, 2007 have been fully considered but they are not persuasive.” The examiner provides detailed remarks in this regard at pages 2-5 of the Advisory Action. For at least the following reasons, Applicant respectfully disagrees with said detailed remarks.

A. None of the applied references teaches or suggests to not irradiate the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon

In response to Applicant’s remark in the April 2007 Response that *none* of the applied references teaches or suggests to *not irradiate* the primer composition layer with UV radiation *prior to* having the UV-curable paint applied thereon, the examiner argues in the Advisory Action that “*none* of the applied references teaches or suggests to *irradiate* the primer composition layer with UV radiation *prior to* having the UV-curable paint applied thereon including Nealon” (emphasis in the original).

Claim 1, however, does not recite “wherein the primer composition layer *is irradiated* with UV radiation prior to having the UV-curable paint applied thereon.” Instead, Claim 1 recites “wherein the primer composition layer is *not irradiated* with UV radiation prior to having the UV-curable paint applied thereon.”

Prior art references, when combined, must teach or suggest each and every recitation of a claim. *See*, MPEP § 2143. In the present case, even if, for the sake of argument, Applicant was to agree that the applied references do not mention irradiating the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon, it would say nothing about whether the applied references teach or suggest the actual recitation in Claim 1, *i.e.*, whether the applied references teach or suggest to *not irradiate* the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon. It is improper for the examiner to conclude that silence with respect to the opposite of a claim recitation amounts to a teaching of the claim recitation. In short, the examiner has not identified a teaching or suggestion in the

applied art to ***not irradiate*** the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon.

B. Nealon teaches away from not irradiating the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon

In addition to the fact that that none of the applied references teaches or suggests to ***not irradiate*** the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon, Applicant stated in the April 2007 Response that Nealon actually teaches away from ***not irradiating*** the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon. At column 4, lines 45-54, Nealon teaches to cure the primer for 10 minutes in a curing oven ***before*** applying the top coat.

In the Advisory Action, the examiner disagrees, arguing that “claim 1 does not exclude a step of partial curing of the primer by heat (as in Nealon) before co-curing the primer and the top coat by UV-radiation” (emphasis in the original).

Applicant’s position, however, does not concern whether Claim 1 excludes or includes curing the primer composition layer by heat before having the UV-curable paint applied on the primer composition layer. Applicant’s point is that Nealon’s teaching at column 4, lines 45-54, to cure the primer for 10 minutes in a curing oven ***before*** applying the top coat amounts to a teaching away from ***not irradiating*** the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon. The examiner herself has argued at page 3, lines 5-16, of the Advisory Action that heat is functionally equivalent to UV-radiation in the present context. Therefore, in addition to the fact that that none of the applied references teaches or suggests to ***not irradiate*** the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon, Nealon’s teaching at column 4, lines 45-54, by the examiner’s own reasoning, would actually lead one of ordinary skill in the art to experiment with irradiating the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon, in direct contrast to the recitation in Claim 1 of ***not irradiating*** the primer composition layer with UV radiation prior to having the UV-curable paint applied thereon.

C. Combining Crast and Jin in the manner proposed by the examiner would not lead to the primer composition layer of Claim 1

The primer composition layer recited in Claim 1 comprises an *aqueous* resin having UV-curable functional groups in a molecule and a crosslinker on the cover surface of a golf ball.

In contrast, at paragraphs [0013] and [0036], Jin clearly states that the advantageous effects and benefits of its invention are tied to the coating being “a nearly 100% solid system” with any remainder being solvent. When the description at paragraphs [0013] and [0036] of Jin is considered in combination with Jin’s criticism of water-borne coatings at paragraph [0007], it is clear that combining Crast and Jin in the manner proposed by the examiner would not lead to the *aqueous* resin-containing primer composition layer of Claim 1.

D. Jin teaches away from the proposed combination of Jin and Lokai

In response to Applicant’s remark in the December 2006 Amendment that Jin criticizes, discredits, or otherwise discourages modifying its solvent-free coating by reformulating it as a water-based composition, the examiner argues in the Advisory Action that “it would be obvious to a person of ordinary skill in the art to use a water-borne coating composition ... when drying time of ½ hour is not crucially important.”

The examiner’s analysis of Applicant’s argument against the combination of Jin and Lokai is improper. As stated above, Jin clearly states at paragraphs [0013] and [0036] that the advantageous effects and benefits of its invention are tied to the coating being “a nearly 100% solid system” with any remainder being solvent. Reformulating Jin’s solvent-free coating as a water-based composition would be completely contrary to Jin’s teachings.

Also, Applicant disagrees that the present “teaches away” argument based on Jin’s criticism of aqueous coatings can be dismissed by hypothesizing that the aspect being criticized by the prior art may not in all instances be crucial. If the examiner’s approach were to be considered proper, not a single “teaches away” argument would ever stand scrutiny. The fact of the matter is that Jin contains at paragraph [0007] a blanket criticism of water-borne coatings based on the drawback of long curing time. The ½ to 4 hours time range is merely an example identified in Jin.

Further, the examiner's emphasis on "**current**" compositions is not understood. At the time of the invention of Jin (June 8, 2001), family members of Lokai (*e.g.*, EP 1 043 351 A2) had already been published and were thus "current."

For each of the foregoing reasons, withdrawal of the present §103 rejection is requested.

II. RESPONSE TO REJECTION UNDER 35 U.S.C. § 103

Referring to Section No. 7 at pages 3 and 4 of the final Office Action, Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Crast in view of Jin, further in view of Lokai, and further in view of Nealon, and further in view of U.S. Patent No. 5,089,376 ("Setthachayanon").

Applicant respectfully traverses.

Claim 4 depends from Claim 1. As stated at Section I above, the combination of Crast in view of Jin, further in view of Lokai, and further in view of Nealon does not teach or suggest the subject matter of Claim 1. Setthachayanon does not cure the deficiencies in the applied art identified at Section I above. In fact, Setthachayanon is merely relied upon solely for its alleged teaching concerning introducing a carboxyl moiety into a urethane (meth)acrylate polymer. Accordingly, Claim 4 is also patentable, at least by virtue of its dependence from Claim 1.

Withdrawal of the present §103 rejection is requested.

Respectfully submitted,

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